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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,878	06/29/2001	Tamra L. Thomason	10004746-1	1016

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

THOMPSON, JAMES A

ART UNIT PAPER NUMBER

2624

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/896,878

Applicant(s)

THOMASON, TAMRA L.

Examiner

James A. Thompson

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 19 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-11 and 13-31.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

1. The proposed amendments to the claims have been entered since said amendments do not substantially change the consideration of the claims with respect to patentability. Although claim 31 now depends from a different claim (claim 30) than previously (claim 29), the reasons for rejection of the claim are not altered. The amendment to claim 29 is merely a formal matter, and is thus entered.

### *Response to Arguments*

2. Applicant's arguments filed 19 September 2005 have been fully considered but they are not persuasive.

Regarding page 9, line 6 to page 14, line 12: Applicant objects to the combination due to the different intended uses of the systems taught by Schmid (US Patent 5,659,164) and Walsh (US Patent 5,496,071). Applicant specifically argues that "[t]here is no reason why a person having ordinary skill in the art would think to combine Walsh's bar code information to Schmid's documents at least because the Schmid system is only concerned with distinguishing between documents and sending them to the intended recipients. In other words, Schmid is not concerned about identifying an author or publisher name associated with the documents. The reason for this appears simple: Schmid's system is not a research tool but instead is a tool that is useful in digitizing hard copy documents in an office setting" [page 12, line 25 to page 13, line 4 of Applicant's present arguments].

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Examiner responds that Schmid is a general system for automatically creating, identifying, routing and storing digitally scanned documents. Although Schmid may have conceived of the system to be used in an office setting, there is no reason why the system taught by Schmid cannot be used in other settings, such as a university or research lab setting. The system taught by Schmid is in no way inherently limited only to use in an office. Furthermore, Schmid uses barcodes to place electronic information on the digitized hard copy documents. Walsh teaches the use of barcodes to place *specific* electronic information on a digitized hard copy document. By combining the teachings of Walsh with the teachings of Schmid, the result would be the system of Schmid which uses the specific kind of digital data taught by Walsh. This is clearly not a difficult task for one of ordinary skill in the art at the time of the invention. It is merely a matter of *which particular type* of data is to be used in tracking the digitized hard copy documents. Furthermore, the motivation that one of ordinary skill in the art at the time of the invention would have had to combine the teachings of Walsh with Schmid, along with how the references are combined, is clearly given page 4, lines 3-12 of the previous office action, dated 13 July 2005. Applying the teachings of Walsh to the teachings of Schmid would provide for the proper indexing of documents for ease of later retrieval (column 4, lines 5-12 of Walsh).

Applicant further objects to the combination of the Ellis reference (US Patent 6,218,964 B1) by alleging that there is no proper basis to incorporate the functionality of Schmid's desktop scanner into Ellis's digitizing pen, and alleges that this is improper hindsight reasoning. Examiner responds that

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both the scanner of Schmid and the digitizing pen of Ellis are both digitizing scanners. Ellis simply teaches a different specific type of digitizing scanner. Clearly, it would be a simple matter for one of ordinary skill in the art at the time of the invention to merely choose a different type of digitizing scanner. Since both the teaching of the handheld scanner and the motivation to combine are within the grasp of one of ordinary skill in the art at the time of the invention, as demonstrated on page 4, line 13 to page 5, line 4 of said previous office action, the combination is proper and does not in any way use improper hindsight reasoning.

In summary of the above points, combining the teachings of Walsh simply adds a specific type of digital tracking data for the hard copy documents and combining the teachings of Ellis simply substitutes one type of digital scanner for another. Both of these slight modifications are clearly well within the abilities of one of ordinary skill in the art at the time of the invention.

**Regarding page 14, lines 13-23:** Applicant alleges that there is no separate capture of source information. Examiner responds that a separate capture of source information is demonstrated in the relevant portions of Schmid cited in said previous office action. Specifically, Schmid states that the "scanner S is supplementarily equipped, either internally or by external equipment, with an apparatus MRI code reader R to identify during the scanning of the cover page 1, the fact that it is a cover page" [column 4, lines 28-33 of Schmid]. Thus, the scanner captures the document data itself and the MRI code reader reads the source data code. Therefore, the capture of

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the source information is clearly separate from the capture of the content.

**Regarding page 14, line 24 to page 15, line 3:** Applicant alleges that there is no association of content and source information. *Examiner responds* that the cited portions of Schmid clearly teach said association. Specifically, Schmid states that "all pages (now in digital format) are electronically 'stapled' or assembled into a single identifiable entity" [column 4, lines 40-42 of Schmid]. Since all the pages of a particular document are assembled together, then clearly the source information is associated with the content information. Otherwise, the pages could not be assembled into a single identifiable entity.

**Regarding page 15, lines 4-10:** Despite Applicant's allegations, the MRI reader is in fact a separate component, and thus a separate scan head. The MRI reader can either be an internal component of the scanner or an external device associated with the scanner (column 4, lines 28-33 of Schmid, as quoted above). If the MRI reader is an external device, then the MRI reader is clearly a separate scan head. If the MRI reader is an internal component, then it is still a separate scan head since said MRI reader is a separate component and reads a different type of digital data.

**Regarding page 15, lines 11-13:** The "separately" limitation has already been discussed above.

**Regarding page 15, lines 14-18:** Column 3, lines 5-11 of Walsh describes information such as the author name, publisher name, and subject index number. This is commonly understood as bibliographic information. Surely bibliographic information can

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be used to retrieve bibliographic information (both the itself and further bibliographic information).

**Regarding page 15, lines 19-25:** As discussed above, separate information capture is indeed performed. Furthermore, Ellis teaches that different modes can be selected using a function key of the handheld scanning device (figures 4A-4B and column 3, lines 51-56 of Ellis). By combining the teachings of Ellis with the teachings of Schmid in view of Walsh, the modes to be selected between would be the two separate information capture modes.

**Regarding page 16, lines 1-3:** The limitations of claim 26 have clearly been taught in column 4, lines 38-43 of Schmid, as discussed in said previous office action.

**Regarding page 16, lines 5-24:** Applicant's arguments contained in this portion are essentially the same arguments rebutted above.

**Regarding page 17, lines 1-25:** The alleged lack of motivation to combine and the alleged lack of teaching with regard to associated source information has already been discussed in detail above.

**Regarding page 17, line 26 to page 18, line 4:** Applicant merely alleges that certain limitations are not taught by the references. Schmid teaches means for automatically creating at least one identifier in the user application (column 4, lines 22-29 of Schmid). Walsh teaches the creation of source acknowledgments. By combination Schmid in view of Walsh teaches means for automatically creating at least one source acknowledgement in the user application using the received association indication. Further, by combination, Schmid in view of Walsh teaches the automatic creation of a bibliography and

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retrieving bibliographic information [see pages 7-9 of said previous office action].

Regarding page 18, line 6 to page 19, line 2: The limitations that Applicant alleges are not taught by the cited prior art references have already been discussed in detail above.

Regarding page 19, line 4 to page 20, line 20: The limitations that Applicant alleges are not taught in claims 20, 21 and 28 have already been discussed in detail above. Further, Applicant merely alleges that certain limitations contained in claims 29 and 30 are not taught by the cited prior art references. The arguments regarding claims 29 and 30 are listed on pages 15-16 of said previous office action and discuss in detail how the combination of references fully teaches the limitations of claims 29 and 30.

Regarding page 20, line 21 to page 21, line 6: Applicant merely alleges that the references are not combinable and do not fully teach the limitations of the claims without providing substantive reasons as to why Applicant believes this to be so.

#### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Thompson whose telephone number is 571-272-7441. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



21 October 2005

James A. Thompson  
Examiner  
Art Unit 2624



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